

REMARKS

The Office Action

Claims 23, 31, 36, 39, 41 and 42 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,456,984 to Demoff, et al. ("Demoff") in view of U.S. Patent No. 5,903,878 to Talati, et al. ("Talati").

Claim 24 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Demoff in view of Talati as applied to claim 23, and further in view of U.S. Patent No. 6,012,045 to Barzilai, et al. ("Barzilai").

Claims 26-30 and 38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Demoff in view of Talati as applied to claim 23, and further in view of U.S. Patent No. 6,226,624 to Watson, et al. ("Watson").

Claims 32-34 and 40 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Demoff in view of Talati as applied to claim 31, in view of U.S. Patent No. 6,315,193 to Hogan ("Hogan") and further in view of U.S. Patent No. 6,381,587 to Guzelsu ("Guzelsu").

Claim 35 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Demoff in view of Talati in view of Hogan in view of Guzelsu as applied to claim 32, and further in view of U.S. Patent No. 5,657,388 to Weiss ("Weiss").

Comments/Arguments

The rejections of the claims are hereby traversed. The foregoing rejections are all based totally or in part on the combination of Talati with Demoff. Inasmuch as this combination is improper, the rejections should be withdrawn.

It is well settled that the initial burden for establishing a *prima facie* case of obviousness rests upon the Examiner. See The Manual of Patent Examining Procedure (MPEP) §2142. The Examiner has not done so in this instance. Again, the MPEP is instructive on this point. Specifically, when making a rejection under 35 U.S.C. §103, the Examiner is required to set forth in the Office Action "the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter." See MPEP §706.02(j) (C). The Examiner in the present case has not fulfilled this requirement in the

Office Action. Rather, the Examiner merely alleges that it would have been obvious to modify Demoff to include the steps as taught by Talati. Nowhere does the Office Action indicate with any specificity how Demoff is to be altered by Talati. That is to say, no modification of Demoff is proposed. Rather, the Office Action merely concludes that it would have been obvious to include the teachings of Talati in the teaching of Demoff. Such a conclusory unsupported allegation does not satisfy the requirements of MPEP §706.02(j) (C). Accordingly, the Office Action does not present a *prima facie* case of obviousness. The rejections of the claims under 35 U.S.C. §103(a) base upon the combination of Talati with Demoff, therefore, should be withdrawn.

However, should the Examiner seek to maintain the rejections, it is respectfully requested that Examiner set forth the proposed modification of the applied references required to arrive at the claimed subject matter as required by MPEP §706.02(j) (C). Moreover, if the rejection is repeated in a subsequent Office Action, it respectfully submitted that such subsequent Office Action should not be made final, inasmuch as the present Office Action has not met the initial burden of establishing a *prima facie* case of obviousness, and the Applicant has not been afforded a fair opportunity to reply to the incomplete and/or inadequately supported rejection. According to MPEP §706.02(j), "It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply." Without knowing how the Examiner proposes to modify the applied references, the Applicant cannot fully reply to the present rejection. Moreover, if the Examiner waits to set forth the proposed modifications in a subsequent Office Action that is made final, then Applicant is denied a fair opportunity to reply to the rejection.

Additionally, according to MPEP §2143.01 (VI), "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." Combining Talati with Demoff would, in fact, impermissibly change the principle of operation of Demoff. Accordingly, such a combination is inappropriate and the rejections based wholly or in part thereon are fatally flawed.

More specifically, Demoff is directed to providing for temporary credit authorizations. Demoff proposes a system wherein a buyer requests from a service provider and is issued a temporary credit card number that the buyer then uses to make a specific purchase or transaction. Furthermore, to later identify the buyer, Demoff teaches that a unique personal ID is associated with the transaction when the temporary credit card number is requested by the buyer from the service provider. This unique ID is derived from either a session ID or a telephone number depending on the manner in which the buyer submitted the request for the temporary credit card number from the service provider. Accordingly, without the buyer making the request to the service provider (e.g., via an Internet connection or telephone call), no unique personal ID can be associated with the transaction, insomuch as no session ID or telephone number is established that can identify the buyer. That is to say, without the unique personal ID (which is derived from the Internet session or telephone call between the buyer and the service provider when the buyer requests the temporary credit card number from the service provider), the invention of Demoff would not be able to later identify and/or authenticate the buyer when the transaction was completed. This is a fundamental principle of operation upon which the invention of Demoff relies. Accordingly, any proposed modification of Demoff that changes this principle of operation is inappropriate.

Nevertheless, the Office Action suggests combining Talati with Demoff. In Particular, the Office Action states that "Talati teaches receiving a purchase request of the buyer from the seller." However, this is a selective reading of Talati, and the teaching is taken out of context. What Talati in fact teaches is that the buyer (i.e., originator) provides the seller (i.e., recipient) a transaction request that includes a credit card or account number (i.e., originator ID or OID) and in turn the recipient relays the request to the transaction administrator. Moreover, the buyer later validates the transaction using a unique transaction identifier (UTID) that they provided with the request. Accordingly, for the seller to provide the transaction request to the transaction administrator, the seller must first be provided the actual credit card or account number of the buyer. This is precisely the type of thing Demoff is attempting to guard against.

Consequently, modifying Demoff so that it employs the transaction request taught by Talati frustrates the very purpose and/or goal of the Demoff invention and in fact impermissibly changes the principle of operation of Demoff. Moreover, to the extent that when Demoff is modified the service provider would now be receiving the alleged purchase request from the seller, then this eliminates the need for the buyer to make a request from the service provider, and accordingly, no session ID or telephone ID is obtained by the service provider from which a unique personal ID can be derived for later identifying and/or authenticating the buy at the time the transaction is completed. In essence, such a modification would render the invention of Demoff inoperable and/or unsatisfactory for its intended purpose. According to MPEP §2143.01(V), such modification are also impermissible.

Therefore, insomuch as all the claim rejections rely at least in part on the improper combination of Talati with Demoff, it is respectfully submitted that the rejections are fatally flawed and that in fact the claims define patentably over the prior art.

CONCLUSION


For the reasons detailed above, it is respectfully submitted that all the claims remaining in the application are now in condition for allowance.

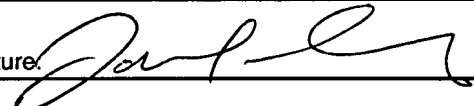
Respectfully submitted,

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Date


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